

Serial No. 09/252,485  
Page 8 of 12

### **REMARKS**

In the final Office Action, the Examiner notes that claims 42, 43, 46-54, 57, 60-64, 74 and 77-79 are pending and rejected. By this response, none of the claims are amended.

In view of the following discussion, Applicant submits that none of the claims now pending in the application lack adequate written disclosure or obvious under the respective provisions of 35 U.S.C. §112 and 103.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record nor to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

### **STATEMENT OF SUBSTANCE OF INTERVIEW**

The Applicants thank the Examiner for the courtesies shown during the telephone interview on October 28, 2005. The Examiner and Applicants' representative discussed the 112 rejection. The Applicants' representative explained that the specification shows support for the picture on picture feature could be on an upgrade card. The Examiner disagreed and maintained that there is no specific teaching of the PIP upgrade card. Agreement was not reached.

### **REJECTIONS**

#### **35 U.S.C. §112**

##### **Claims 42-43, 46-54, 57, 60-64, 74 and 79**

The Examiner has rejected claims 42-43, 46-54, 57, 60-64, 74 and 79 under 35 U.S.C. §112, ¶1, as containing subject matter which was not described in the specification in such a ways as to reasonably convey to one skilled in the relevant art that the Inventor(s) at the time the invention was filed had possession of the claimed invention. Applicant respectfully traverses the rejection.

The Examiner asserts that the specification of the present invention fail to reasonably convey to one skilled in the art that the inventors at the time the invention

402058-1

Serial No. 09/252,485  
Page 9 of 12

was filed had possession of "components are located on an upgrade card insertable into an existing set top terminal to provide digital picture-on-picture capability" and "wherein the second signal processing components are located on an expansion card inserted into the apparatus." Applicants respectfully disagree.

35 U.S.C. §112, ¶1 does not require the detailed description to have a word-for-word description of the claimed invention to satisfy the written description requirement. Instead, the requirement is that the application *reasonably conveys* the claimed subject matter. See, *Ex parte Parks*. The originally filed disclosure would have conveyed to one of ordinary skill in the art the concept of using an upgrade card to provide picture-on-picture capabilities.

Specifically, the detailed specification explicitly states that expansion cards may be designed to accommodate any hardware upgrade compatible with the set top terminal. (See, page 44, lines 22, 24). In the same disclosure, the detailed specification explicitly states that picture-on-picture capabilities are considered to be upgraded hardware components. (See, page 49, lines 13-15). Because the specification as originally filed in the parent application explicitly states that the card could include any upgrades and picture-on-picture is an upgrade in that specification, it is clear for one of ordinary skill in the art reading the specification that the applicants had invented designing upgrade cards to accommodate picture-on-picture capabilities compatible with the set top terminal. In addition, the application clearly conveys and reasonably describes the concept of designing expansion cards in order to accommodate picture-on-picture capabilities compatible with the set top terminal in the sections listed above. There should be no question that an ordinary person skilled in the art at the time of the invention would conclude that the inventors had possession of the concept of upgrading cards with picture-on-picture capabilities. Thus, the Examiner failed to prove a prima facie case of lack of written description.

As such, Applicant submits that claims 42-43, 46-54, 57, 60-64, 74 and 79 satisfy the requirements of 35 U.S.C. §112 and are patentable thereunder. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

Serial No. 09/252,485

Page 10 of 12

### **35 U.S.C. §103**

#### **Claims 77-78**

The Examiner has rejected claims 77-78 under 35 U.S.C. §103(a) as being unpatentable over Arai (of record) in view of Willis (of record) and further in view of Ryu (of record). Applicant respectfully traverses the rejection.

*The detailed rejection uses the Wasilewski reference rather than the Willis reference as stated above. The applicant assumes the Examiner is referring to Wasilewski in the rejection of claims 77-78.*

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The combination of Arai, Wasilewski and Ryu fails to teach or suggest Applicant's invention as a whole.

Arai discloses a television apparatus with picture-in-picture capabilities. As pointed out by the Examiner, Arai failed to disclose many aspects of the present invention including utilizing upgrade card inserted into an existing set-top terminal or any upgrade ports. Wasilewski discloses multiplexing a plurality of television signals for transmission to a plurality of locations. Again, as pointed out by the Examiner, this reference fails to point out utilizing upgrade card inserted into an existing set-top terminal or any upgrade ports. Ryu discloses selection of sound mode depending on the selected channel. This reference also fails to disclose, teach or suggest the utilization of upgrade card inserted into an existing set-top terminal or any upgrade ports.

Even if the three references could somehow be operably combined, the combination would merely disclose a television apparatus with picture-in-picture capabilities for receiving digital television programming and having the ability to selectively output audio signals. Nowhere in the combined references is there any

402058-1

Serial No. 09/252,485  
Page 11 of 12

teaching or suggestion of the usage of an upgrade card inserted into an existing set-top terminal or any upgrade ports. Therefore, the combined references fail to teach or suggest Applicant's invention as a whole.

Claim 77 has the limitations of an apparatus comprising tuners and decompressors wherein at least one of the tuners and at least one of the decompressors is located on an upgrade card. As stated above, Arai, Wasilewski and Ryu do not teach or suggest any upgrade cards. Thus, claim 77 is not obvious and fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder.

Claim 78 has the limitations of a set top terminal comprising first signal components and a second signal components and an upgrade port. None of Arai, Wasilewski and Ryu discloses, teaches or suggests the use of upgrade ports. Thus, claim 78 is not obvious and fully satisfy the requirement of 35 U.S.C. § 103 and are patentable thereunder.

According to MPEP 2143.03, "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Because not all the limitations of claims 77 and 78 are disclosed, taught or suggested, they are not obvious and fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder. Therefore, Applicant respectfully requests that the rejection be withdrawn.

### **CONCLUSION**

Thus, Applicant submits that claims 42, 43, 46-54, 57, 60-64, 74 and 77-79 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jasper Kwok at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Serial No. 09/252,485  
Page 12 of 12

Respectfully submitted,

11/29/05

E J Wall

Eamon J. Wall, Attorney  
Reg. No. 39,414  
(732) 530-9404

Patterson & Sheridan, LLP  
Attorneys at Law  
595 Shrewsbury Avenue, 1st Floor  
Shrewsbury, New Jersey 07702